



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,061	03/02/2004	Jaime Simon	42801C	2855
109 7590 08/27/2009 The Dow Chemical Company Intellectual Property Section P.O. Box 1967 Midland, MI 48641-1967				
EXAMINER				
FISHER, ABIGAIL L				
ART UNIT		PAPER NUMBER		
1616				
MAIL DATE		DELIVERY MODE		
08/27/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/791,061

Applicant(s)

SIMON ET AL.

Examiner

ABIGAIL FISHER

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 August 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-5.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Mina Haghighatian/
Primary Examiner, Art Unit 1616

Continuation of 11, does NOT place the application in condition for allowance because: Amendments are entered, however they do not overcome the rejections. Regarding the rejections made under 35 USC 101 and 112 2nd paragraph, applicants reply and amendments have not overcome the rejection. The claim as written is still a use claim. Proper US practice for method claims, if that is what applicants are attempting to claim, recite a method of... Therefore, the rejections are still maintained as the claims are still directed to use claims.

Regarding the 103 rejection, firstly the examiner would like to acknowledge applicants argument regarding the respective chemistries presented. While allylamine would not produce the alkyl amines of Rogers, WO '184 specifically teaches that the formula (see page 4 of the document) includes trisubstituted N wherein the substitution is H (allyl amine) or lower alkyl. As can be seen from the figure on page 4, the extending side chain is CH_2NR_3 which is the same as Rogers. Applicants argue that the crosslinking with epichlorohydrin is optional, however it is specifically exemplified with various polymers. Additionally, there are two different methods of crosslinking taught, one in which the crosslinker is added during the polymerization or one where it is reacted with the polymer after the polymer has formed. Additionally, the crosslinker is present in an amount from 0.5 to 75% (page 9). Therefore, the polymer can be made from mostly the crosslinker and when utilized during the polymerization would also be expected to polymerize. The instant specification does not claim any specific orientation in terms of location or points of attachment of the two different "monomers" only that the polymer backbone comprises a polyether glycol polymer (such as polyepichlorohydrin) and has a moiety which is cationic at physiological pH. This wouldn't exclude other monomers from being present or a polymer made from monomers of epichlorohydrin and monomer(s) comprising an amine. Therefore, the polymers taught in both Rogers and WO '184 would read on the claimed polymers. Since WO'184 teaches that polymers possessing quaternary amine moieties are effective for the removal of phosphates, one of ordinary skill in the art would expect that polymers comprising quaternary amine moieties (such as those taught in Rogers) would also be effective in phosphate removal. Applicants argue that the invention utilizes chelation. It appears applicants believe that the recitation in the instant claims of complexation would claim this. However, the instant specification indicates that chelants are a type of complexing agent (page 5 of instant specification). Therefore, they would be a species of complexation. An ionic interaction would also be a complexation and would read on the instant claims. Secondly, the instant claims recite a moiety on the backbone of the polymer. This means as long as one amine is present, it would read on the instantly claimed structure. However, applicants have argued that in order for chelation to occur two or more amines would be required. However, this limitation is not found in the claims.